

REMARKS

Claim 29 has been added to address certain embodiments of Claim 7 which (as more fully recited in the claim itself) comprise a synergistic combination; Claim 30 has been added to address embodiments of Claim 7 comprising 2,6-dichloro-*N*-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide, famoxadone and metalaxyl; and Claim 31 has been added to address embodiments of Claim 30 comprising a synergistic combination of 2,6-dichloro-*N*-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide and famoxadone. Claims 19, 22 and 23 have been canceled without prejudice to limit the total number of pending claims to twenty.

By Office Action dated August 20, 2008, the above-referenced application has been made subject to a requirement to restrict. The Office Action indicated that the requirement was based on unity of invention considerations, that the composition claims were being grouped into 9 claim groups; and that the method claims would be examined along with certain of the composition groups. The Office Action submitted that the combination of component (a) and component (b2) would have been obvious to one of ordinary skill in the art over the teachings of U.S. Patent 6,503,933 (Maloney et al.), U.S. Patent 6,066,638 (Bereznak et al.) and Jordan et al., Pesticide Science 55: 105-118 (1999); and that unity between these claims is thus broken. The Office Action also indicated that for a reply to the requirement to be complete, it must include (i) an election of a species or invention to be examined, and (ii) identification of the claims encompassing the elected invention.

The courtesy accorded the undersigned attorney and Ms. Sternberg in the telephone conference of October 15, 2008, is acknowledged and appreciated. In the telephone conference it was questioned why many of the claims that appeared directed to a combination of component (a) with component (b2) were grouped in separate groups. Examiner Woodward suggested that although this combination included in Group I might be considered a “technical feature” it was not considered a “special technical feature” sufficient to link the groups of claims because it was considered unpatentable. The undersigned attorney suggested the issue of patentability of the combination should be a question subject to review by the appeal process, and that accordingly, claims addressing the combination of component (a) with component (b2) should remain under consideration, even if Applicants are asked to elect from amongst the various third active ingredients included in some of the claims. Examiner Woodward did not agree that this was in accord with the “unity of invention” criteria, but noted that the issue was one that could be petitioned. The undersigned attorney questioned in particular the reason for the separate groupings II and III (which both include, for example, Claim 6) and the reason for the separate grouping of Claim 18 (included in Group IV) and

Claim 17 (included in Group I). Examiner Woodward observed that the issue with regard to Claim 6 could relate to the “clarity” issue indicated in the Office Action. In connection with the undersigned Attorney’s question regarding the treatment of Claim 24, Examiner Woodward indicated that “synergy” can be considered a “special technical feature” worthy of separate grouping.

Applicants hereby elect group III, with traverse. Applicants note that the Office Action did not include the form paragraph (paragraph 8.20) suggested near the end of MPEP Section 1893(d) to be used when making an election of species requirement in a national stage application, and that the form paragraph appears to allow for clearly identifying what are considered the species from which Applicants can elect as well as clearly identifying claims that are considered generic. Nevertheless, with regard to the requirement to specify a particular combination, Applicants elect the combination comprising component (a) and component (b2); and more particularly with regard to specification of a third component, Applicants elect to the extent required the combination comprising component (a) and component (b2) that further comprises component (b6). With regard to a particular compound within each of the component groups, Applicants elect to the extent required to select particular compounds, the compound of Claim 17 as a species of component (a), famoxadone as a species of component (b2) and metalaxyl as a species of component (b6). Accordingly, a species of the combination comprising component (a) and component (b2) that further comprises component (b6) would be the combination comprising the compound of Claim 17 and famoxadone that further comprises metalaxyl. Applicants note that above-mentioned form paragraph suggests that Applicants can be required to identify the claims “readable on” the elected species (whereas the Office Action suggests identifying claims “encompassing” the elected invention. In any event, Applicants submit that Claims 1, 2, 4-7, 9, 11, 17, 18, 20, 21 and 24-31 (i.e., all remaining claims) all encompass combinations of the compound of Claim 17, famoxadone and metalaxyl in the sense that they include compositions or methods involving those three compounds within their scope; but only composition claims 6, 7, 21, 26, 29, 30 and 31 involve embodiments that require one component that is or could be the compound of Claim 17 (but not famoxadone or metalaxyl), a second component that is or could be famoxadone (but not the Compound of Claim 17 or metalaxyl) and a third component that is or could be metalaxyl (but not the compound of Claim 17 or famoxadone).

Applicants respectfully disagree that the combination of component (a) and component (b2) would have been obvious to one of ordinary skill in the art over U.S. Patent 6,503,933, U.S. Patent 6,066,638 and Pesticide Science 55: 105-118 (1999); and accordingly, object to all claim groupings which rely on an assertion to the contrary. Applicants also disagree with making this issue a matter for resolution as a part of the restriction process

rather than examination. Applicants submit that Col. 68, lines 58-64 of Bereznak et al. does not suggest combining famoxadone, or any other (b2)compound, with a component (a) compound; and that instead this disclosure is limited to a discussion of combinations including certain fungicidal fused-ring pyrimidinones that are not structurally related to component (a) compounds of the present invention that include both a substituted pyridinyl ring and a substituted phenyl ring that are structurally separated from each other. Applicants further submit that while Col. 3, lines 29-32 of Moloney et al. indicates generally that the compositions can comprise other actives, it does not specifically disclose famoxadone or any other (b2) compound or suggest that (b2) compounds should be combined. Moreover, Applicants submit that Moloney et al. does not disclose or fairly suggest that combinations with (b2) compounds will provide advantageous results as disclosed by Applicants. Applicants submit that the Maloney et al. passage merely suggests to one of ordinary skill that the compositions could be formulated with other actives or could be formulated without other actives, without suggesting whether either alternative should be selected. Applicants submit that this cannot be fairly characterized as making obvious advantageous combinations involving component (a) and component (b2) of the present claims, especially advantageous combinations involving the compound of Claim 17 and famoxadone. Applicants submit that if the Examiner maintains this assertion of obviousness, it is clearly an issue Applicants should be afforded an opportunity to appeal; and all claim groupings relying on this assertion are objected to as relying on a matter which remains unresolved. Accordingly, Applicants object to all separate claim groupings that rely on this assertion of obviousness.

Applicants also submit that it would seem contrary to restriction principles to require them to seek another, separate patent (which might be ultimately be subject to a different patent term and/or ultimately be assigned to a different owner) to obtain claim coverage for a broader “subcombination” (e.g., Claim 18) which has within its scope the SAME product (e.g., a composition comprising the compound of Claim 17, famoxadone and metalaxyl) covered by claims more narrowly covering the “combination” elected by Applicants (e.g. Claim 30).

Applicants also note that certain combinations of component (a) compounds and (b2) compounds have been illustrated to exhibit synergy (see Table A). As noted above, new claims 29 and 31 have been added and as recited therein specifically relates to synergy in connection with Claim 7 compositions and Claim 30 compositions, respectively (i.e., compositions included in elected group III).

Applicants submit that it would seem contrary to restriction principles to require them to seek another, separate patent (which might be ultimately be subject to a different patent

term and/or ultimately be assigned to a different owner) to obtain claim coverage for a broader “subcombination” (e.g., Claim 24) which has within its scope the SAME product (e.g., a composition comprising the compound of Claim 17, famoxadone and metalaxyl which comprises a synergistic combination of the compound of Claim 17 and famoxadone) covered by claims more narrowly covering the “combination” elected by Applicants (e.g., Claim 31).

Applicants note that Section 1893.03(d) indicates that when making a lack of unity of invention requirement, the examiner must (in addition to listing the different groups of claims) explain why each group lacks unity with each other group, specifically describing the unique special technical feature in each group. Applicants submit that no sufficient basis has been identified in the Office Action for the separate grouping of groups I, IV and VIII. More particularly, the description provided for groups IV and VIII do not appear to distinguish from each other or Group I (although, as mentioned above, during the telephone conference of October 15 Examiner Woodward suggested in connection with Claim 24 that synergy can be considered a “special technical feature” worthy of separate grouping).

Applicants also submit that no sufficient basis has been identified in the Office Action for the separate grouping of groups II, VII and IX. More particularly, the description provided for groups VII and IX do not appear to distinguish from each other or Group II (although, as mentioned above, during the telephone conference of October 15 Examiner Woodward suggested in connection with Claim 24 that synergy can be considered a “special technical feature” worthy of separate grouping). With regard to the clarity comment included in the description for these groups, Claim 6 has been amended as indicated above so that the terminology is more consistent with Claim 7 terminology. Applicants submit that this amended claim clearly requires that only one additional (b) compound (besides the (b2) compounds) needs to be present in order to meet the claim limitation, and that this additional compound may be from any of the (b) groups (b1) and (b3) through (b9). Of course, other (b) compounds from any of the (b) groups can also be present. With regard to claims 23 and 26, Applicants submit that these claims are sufficiently clear as written and clearly require that only one compound selected from the recited group of compound categories needs to be present in order to meet the claim limitation, and that this additional compound may be from any of the listed categories (b1) and (b3) through (b9). Of course, other compounds from any of the listed categories can also be present.

Applicants also submit that it would seem contrary to restriction principles to require them to seek another, separate patent (which might be ultimately be subject to a different patent term and/or ultimately be assigned to a different owner) to obtain claim coverage for a “combination” (e.g., Claim 21) which has within its scope the SAME product (e.g., a

composition comprising the compound of Claim 17, famoxadone and metalaxyl) covered by claims of a different scope covering the same “combination” elected by Applicants (e.g., Claim 7).

Applicants note that many of the claims now pending that involve the combination of component (a) and component (b2) (e.g., Claim 1 and Claim 18) have already been examined together. Applicants submit that no adequate basis has been identified to now separate these claims for examination in different groups and no serious burden has been identified in connection with continuing consideration of the claims already properly examined (compare MPEP Section 803).

In view of the foregoing, consideration and allowance of the above-referenced application is respectfully requested.

Respectfully submitted,

/David E. Heiser/

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